

**REMARKS****INTRODUCTION:**

In accordance with the foregoing, claims 1, 9 and 23-25 have been amended, and claims 26-29 have been added. No new matter is being presented, and approval and entry of the foregoing amendments and new claims are respectfully requested. Claims 1-29 are pending and under consideration. Reconsideration is requested.

**RECEIPT OF FOREIGN PRIORITY PAPERS:**

On page 1, box 12, the Examiner does not confirm that the foreign priority documents have been received for the purposes of 35 U.S.C. §119 or recognize the foreign priority claim. As indicated in the Continuing Utility Patent Application Transmittal, the foreign priority documents were filed in the parent application, United States Patent Application No. 10/256,244. As such, the foreign priority documents do not need to be again submitted in the instant application. MPEP 201.14(b)(II). Therefore, it is respectfully requested that the Examiner acknowledge prior receipt of the foreign priority documents received in the parent application and otherwise recognize the foreign priority claim for the instant application.

**REJECTION UNDER 35 U.S.C. §112:**

On page 2 of the Office Action, the Examiner rejects claims 19, 23, and 24 under 35 U.S.C. §112, first paragraph, as not being enabled. The rejection is respectfully traversed and reconsideration is requested.

On page 2 of the Office Action, the Examiner asserts that the specification does not enable recording the information data representing a characteristic of the second multi-pulse as a wobble signal on the optical recording medium as recited in claim 19. As a point of clarification, claim 19 recites, among other features, a recording waveform generating unit that "generates information data representing a characteristic of the second multi-pulse," where "the information data is recorded on the optical recording medium as a wobble signal." As such, claim 19 does not recite that the generated information data is recorded by the apparatus as the wobble signal, but instead, that the information data generated by the generating unit is included in a wobble signal.

While not specifically limited thereto, at least paragraph 0040 of the instant application describes information on one of four types of erase patterns being included in a wobble signal detected by the apparatus. As such, it is respectfully submitted that claim 19 is enabled by the specification and remains compliant with the requirements of 35 U.S.C. §112, first paragraph.

In rejecting claims 23 and 24 on page 2 of the Office Action, the Examiner asserts that the specification does not disclose a servo unit reading information, and instead discloses a servo circuit 12 that controls the motor and the optical head in paragraph 0030. While it is respectfully submitted that one of ordinary skill in the art would understand that the servo unit as recited in claims 23 and 24 could include the optical head 13 or otherwise reads data sufficient for the purposes of 35 U.S.C. §112, claims 23 and 24 have been amended to clarify that, while the servo unit can include both a servo circuit and an optical head, the servo unit is not required to include the optical head as indicated. As such, it is respectfully requested that the Examiner reconsider and withdraw the rejection.

On page 3 of the Office Action, the Examiner rejects claim 19 under 35 U.S.C. §112, second paragraph, as being indefinite. The rejection is respectfully traversed and reconsideration is requested.

The Examiner asserts that claim 19 is indefinite since the information data recited in claim 19 is inconsistent with the information data recited in claim 18 since claim 19 recites that the information data is recorded as a wobble signal. By way of review, claim 19 recites, among other features, a recording waveform generating unit that "generates information data representing a characteristic of the second multi-pulse," where "the information data is recorded on the optical recording medium as a wobble signal." As such, claim 19 does not recite the apparatus recording the information data as a wobble signal as characterized by the Examiner, but does recite generating the information data recorded as a wobble signal. Therefore, it is respectfully requested that the Examiner reconsider and withdraw the rejection of claim 19 under 35 U.S.C. §112, second paragraph.

**REJECTION UNDER 35 U.S.C. §102:**

In the Office Action at pages 3-8, the Examiner rejects claims 1-5, 7-12, 14-16, 18, 20, 21, and 25 under 35 U.S.C. §102 in view of Dekker (U.S. Patent No. 6,600,709). This rejection is respectfully traversed and reconsideration is requested.

By way of review, FIGs. 1A and 1B of Dekker show an erase pulse sequence 14 having a first erase pulse at a high level  $P_e$  and a last erase pulse extending into the recording mark at a bias level  $P_1$  or  $P_2$  according to the writing speed. (Col. 4, lines 16-47; Fig. 2). However, there is no suggestion that the erase pulse sequence 14 has other configurations, or that such configurations would be beneficial.

In contrast, claim 1 recites, among other features, that "a leading one of the second pulses is set to a low level and a power level of a pulse between an end of the second multi-

pulse and a first one of the first pulses of the first multi-pulse is set to a high level." As such, it is respectfully submitted that Dekker does not disclose or suggest the features of claim 1.

For at least similar reasons, it is respectfully submitted that Dekker does not suggest the features of claim 25.

Claims 2-5, 7-12, 14-16, 18, 20, and 21 are deemed patentable due at least to their depending from claim 1.

In the Office Action at pages 8-9, the Examiner rejects claims 1 and 6 under 35 U.S.C. §102 in view of Ichihara (U.S. Patent No. 6,396,792). This rejection is respectfully traversed and reconsideration is requested.

By way of review, Ichihara discloses a waveform of recording pulses having erasure steps used as erasure signals. However, the first step is a high level Pc1 and a last step is a low level Pc2. Moreover, a power between the low level Pc2 is the Pa is between Pc2 and Pa. (Col. 4, lines 45-62; FIGs. 1B and 1C). There is no suggestion in Ichihara that the erasure steps have other configurations, or that such configurations would be beneficial.

In contrast, claim 1 recites, among other features, that "a leading one of the second pulses is set to a low level and a power level of a pulse between an end of the second multi-pulse and a first one of the first pulses of the first multi-pulse is set to a high level." As such, it is respectfully submitted that Ichihara does not disclose or suggest the features of claim 1.

Claim 6 is deemed patentable due at least to its depending from claim 1.

#### **REJECTION UNDER 35 U.S.C. 103:**

In the Office Action at pages 9-10, the Examiner rejects claim 13 under 35 U.S.C. §103 in view of Seo (U.S. Patent Publication No. 2002/0101808). This rejection is respectfully traversed and reconsideration is requested.

By way of review, Seo appears to qualify as prior art under 35 U.S.C. §102(e). In addition, it is noted that Seo was owned by the same person or subject to an obligation of assignment to the same entity with the instant application at the time the invention of the instant application was made. Under 35 U.S.C. §103(c), "[s]ubject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." MPEP 2146, EXAMINATION GUIDELINES FOR 35 U.S.C. 102(E), AS AMENDED BY THE AMERICAN INVENTORS PROTECTION ACT OF 1999, AND FURTHER AMENDED BY THE INTELLECTUAL PROPERTY AND HIGH TECHNOLOGY TECHNICAL

AMENDMENTS ACT OF 2002, AND 35 U.S.C. 102(G), 1266 OG 77 (January 14, 2003). As such, it is respectfully submitted that Seo is not available as prior art for use in an obviousness rejection under 35 U.S.C. §103. Since the Examiner does not rely upon another reference to otherwise show the features of claim 13, it is respectfully submitted that the Examiner reconsider and withdraw the rejection.

In the Office Action at pages 10-11, the Examiner rejects claim 17 under 35 U.S.C. §103 in view of Dekker and Ushiyama et al. (U.S. Patent Publication No. 2002/0176338). This rejection is respectfully traversed and reconsideration is requested.

Even assuming arguendo that the Examiner's construction of Ushiyama et al. is proper, the Examiner does not rely upon Ushiyama et al. as curing the above-noted defect of Dekker as applied to claim 1, from which claim 17 depends. As such, it is respectfully submitted that the combination does not disclose or suggest the features of claim 17 since the combination does not disclose or suggest the features of claim 1.

In the Office Action at page 11, the Examiner rejects claim 22 under 35 U.S.C. §103 in view of Dekker and Ko et al. (U.S. Patent Publication No. 2002/0067673). This rejection is respectfully traversed and reconsideration is requested.

By way of review, Ko et al. appears to qualify as prior art under 35 U.S.C. §102(e). In addition, it is noted that Ko et al. was owned by the same person or subject to an obligation of assignment to the same entity with the instant application at the time the invention of the instant application was made. Under 35 U.S.C. §103(c), "[s]ubject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." MPEP 2146, EXAMINATION GUIDELINES FOR 35 U.S.C. 102(E), AS AMENDED BY THE AMERICAN INVENTORS PROTECTION ACT OF 1999, AND FURTHER AMENDED BY THE INTELLECTUAL PROPERTY AND HIGH TECHNOLOGY TECHNICAL AMENDMENTS ACT OF 2002, AND 35 U.S.C. 102(G), 1266 OG 77 (January 14, 2003). As such, it is respectfully submitted that Ko et al. is not available as prior art for use in an obviousness rejection under 35 U.S.C. §103. Since the Examiner does not rely upon another reference to otherwise show the features of claim 22, it is respectfully submitted that the Examiner reconsider and withdraw the rejection.

**PATENTABILITY OF NEW CLAIMS:**

Claims 26-29 are is deemed patentable due at least to reasons similar to why claim 1 is

patentable over Dekker and/or Ichihara.

**CONCLUSION:**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, it is respectfully submitted that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any additional fees associated with the filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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